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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,504	10/30/2003	Steven W. Trovinger	10991471-13	9590

7590 09/18/2006

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

TRAN, KHOI H

ART UNIT	PAPER NUMBER
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3651

DATE MAILED: 09/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/698,504

Applicant(s)

TROVINGER ET AL.

Examiner

Khoi H. Tran

Art Unit

3651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 40, 41 and 63-78 is/are pending in the application.
- 4a) Of the above claim(s) 64-70 and 72-78 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 40, 41, 63, and 71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

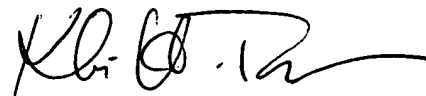
## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.



KHOI H. TRAN

PRIMARY EXAMINER

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 40, 41, 63, and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bober 4,595,187 in view of Albright et al. 6,120,015.

Bober '187 discloses a method for stacking sheets of printing media that includes collecting the sheets on a workpiece (79) sheet by sheet; registering (80, 81) the sheets on the workpiece sheet by sheet; and unloading the stack from the workpiece (see col. 4, lines 30-33). Bober discloses all the limitations of the claims, but it does not disclose punching a hole/cutting a notch in the sheets, sheet by sheet.

Albright et al. '015 disclose a sheet punching/cutting device that punches/cuts sheets, sheet by sheet, before transferring the sheets to a finisher for the purpose of punching/cutting sheets without interrupting their rapid sequential sheet printing and output, yet allowing improved, more positive, sheet control and a lower punching/cutting force as compared to compiling and hole punching/cutting through an entire set of sheets at once (see col. 2, lines 35-48).

It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Bober '187 by punching/cutting the sheets sheet by sheet, as disclosed by Albright et al. '015, for the purpose of punching/cutting sheets

without interrupting their rapid sequential sheet printing and output, yet allowing improved, more positive, sheet control and a lower punching/cutting force as compared to compiling and hole punching/cutting through an entire set of sheets at once.

It is obvious that when the sheets in modified Bober '187 are registered and aligned edge-wise, the punch holes of each sheet are also aligned and registered.

3. Claims 40, 41, 63, and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farrell et al. 5,461,469 in view of Albright et al. 6,120,015

Farrell et al. '469 disclose a method for stacking sheets of printing media that includes punching a hole/cutting a notch in sheets (see col. 11, line 67); collecting the sheets on a workpiece sheet by sheet (see col. 11, line 20 incorporating U.S. 4,595,187 by reference); registering the sheets on the workpiece sheet by sheet (see col. 11, line 20 incorporating U.S. 4,595,187 by reference); and unloading the stack from the workpiece (see col. 11, lines 15-19). Farrell et al. '469 disclose all the limitations of the claims, but it does not disclose punching a hole/cutting a notch in the sheets, sheet by sheet. Rather, Farrell et al. '469 is silent as to how the punching/cutting occurs.

Albright et al. '015 disclose a sheet punching/cutting device that punches/cuts sheets, sheet by sheet, before transferring the sheets to a finisher for the purpose of punching/cutting sheets without interrupting their rapid sequential sheet printing and output, yet allowing improved, more positive, sheet control and a lower punching/cutting force as compared to compiling and hole punching/cutting through an entire set of sheets at once (see col. 2, lines 35-48).

It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Farrell et al. '469 by punching/cutting the sheets sheet by sheet, as disclosed by Albright et al. '015, for the purpose of punching/cutting sheets without interrupting their rapid sequential sheet printing and output, yet allowing improved, more positive, sheet control and a lower punching/cutting force as compared to compiling and hole punching/cutting through an entire set of sheets at once.

It is obvious that when the sheets in modified Farrell et al. '469 are registered and aligned edge-wise, the punch holes of each sheet are also aligned and registered.

#### ***Response to Arguments***

4. Applicant's arguments filed 07/28/2006 have been fully considered but they are not persuasive.

Applicant argued that the Examiner has failed to enumerate mutually exclusive embodiments of the claimed invention, in order to allow Applicant an opportunity to elect an invention. This argument is not persuasive. Since Applicant has received an action on the merits of the originally presented claims, it is the Office's position that Applicant had already constructively elected a specific embodiment by way of original presentation and prosecution of the claims.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Bober 4,595,187 and Farrell et al. 5,461,469 by punching/cutting the sheets sheet by sheet, as disclosed by Albright et al. 6,120,015, for the purpose of punching/cutting sheets without interrupting their rapid sequential sheet printing and output, yet allowing improved, more positive, sheet control and a lower punching/cutting force as compared to compiling and hole punching/cutting through an entire set of sheets at once.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

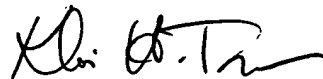
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3651

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoi H. Tran whose telephone number is (571) 272-6919. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Khoi H Tran  
Primary Examiner  
Art Unit 3651

KHT  
09/12/2006